

Application No. 10/803,698  
Reply to Office Action of February 28, 2006

Docket No.: 65937-0047

### **REMARKS**

This response is intended to be fully responsive to the non-final Office Action ("Office Action") having a mailing date of February 28, 2006, wherein claims 1-29 were rejected.

#### **Claim Rejections – 35 U.S.C. § 102**

Claims 1-29 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 6,554,779 to Viola et al. ("Viola"). However, Viola fails to teach or suggest several elements of Applicants' claims. Therefore, the foregoing Section 102 rejections should be withdrawn.

#### **A. The Law**

To anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

#### **B. Independent Claim 1**

Independent claim 1 recites in part:

a base;  
a cradle moveably mounted to the base and configured to rotatably support the biopsy device therein, the cradle configured to inhibit axial movement of the biopsy device relative to the cradle when locked therein;  
an indexing guide moveable with the cradle and including a receptacle within which the outer cannula hub is rotatably received, the indexing guide configured to inhibit rotation and axial movement of the outer cannula hub and outer cannula relative to the indexing guide and the cradle when the outer cannula hub is locked therein.

Application No. 10/803,698  
Reply to Office Action of February 28, 2006

Docket No.: 65937-0047

(Emphasis added). Viola does not show “a cradle moveably mounted to the base and configured to rotatably support the biopsy device therein,” “an indexing guide moveable with the cradle,” and “the indexing guide configured to inhibit rotation and axial movement of the outer cannula hub and outer cannula relative to the indexing guide and the cradle when the outer cannula hub is locked therein,” as claim 1 recites. Indeed, Viola does not even disclose a handpiece.

a. “a cradle moveably mounted to the base and configured to rotatably support the biopsy device therein”

Claim 1 recites “the biopsy device including a handpiece,” and “a cradle moveably mounted to the base and configured to rotatably support the biopsy device therein,” (emphasis added) that Viola does not disclose. Indeed, the cradle must rotatably support the biopsy device, where the biopsy device includes a handpiece. However, Viola does not teach or even discuss a handpiece. Nor does Viola disclose or teach a moveable cradle configured to rotatably support a biopsy device. Indeed, Viola teaches away from both claim elements.

The Examiner cited a passage from Viola that does not disclose the claim elements. (See the Office Action, Page 2; Viola, Col. 7, Lines 6-21). Viola merely discloses a base 64 (see FIGS. 1, 3) and does not include the “biopsy device including a handpiece” and a “cradle moveably mounted to the base” and “configured to rotatably support the biopsy device therein.” Thus, because Viola does not disclose each and every element of claim 1, claim 1 is patentable.

a) “a cradle moveably mounted to the base”

Viola does not disclose “a cradle moveably mounted to the base,” as claim 1 recites. Indeed, Viola discloses a cradle (near 44) as rigidly connected to base 64. (See FIG. 3). Accordingly, Viola does not disclose a movable cradle in any way as positively claimed by Applicants.

Thus, for at least these reasons, claim 1 is in condition for allowance.

b) “configured to rotatably support the biopsy device”

Viola also does not show a cradle “configured to rotatably support the biopsy device,” as claim 1 recites. Viola clearly discloses a biopsy device 22 that is received (shown by a dashed

Application No. 10/803,698  
Reply to Office Action of February 28, 2006

Docket No.: 65937-0047

line) by a knife driver subassembly 44 in base 64. (See FIG. 3). The connection of biopsy device 22 to subassembly 44 is in a non-rotating manner. (See FIG. 3). Further, the connection of biopsy device 22 to base 64 is also in a non-rotating manner. (See FIG. 3).

Thus, because Viola does not disclose a cradle "configured to rotatably support the biopsy device," for this separate reason claim 1 is in condition for allowance.

**c) "handpiece"**

As described by claim 1, the biopsy device includes a handpiece. At best, Viola discloses a biopsy instrument 22 that is contemplated as a permanent fixture type. (See Col. 4, Lines 26-28; FIG. 1). However, Viola does not disclose a "handpiece."

Thus, because Viola does not disclose a "biopsy device including a handpiece," claim 1 is in condition for allowance.

**b. "an indexing guide moveable with the cradle"**

Additionally, the Examiner has not shown "an indexing guide moveable with the cradle," as claim 1 recites. (Emphasis added). Viola shows a slide block 74 that receives an indexer 140. (See Col. 8, Lines 36-46; FIG. 3). However, the outer tube 36 is not rotatably received by an indexing guide. Indeed, Viola discloses a tissue retract mechanism 68 that moves independent of base 64. (See FIG. 3). Therefore, Viola teaches away from claim 1.

Thus, because Viola does not disclose "an indexing guide moveable with the cradle," claim 1 is in condition for allowance.

**c. "the indexing guide configured to inhibit rotation and axial movement of the outer cannula hub and outer cannula relative to the indexing guide and the cradle when the outer cannula hub is locked therein"**

Moreover, the Examiner has not shown "the indexing guide configured to inhibit rotation and axial movement of the outer cannula hub and outer cannula relative to the indexing guide and the cradle when the outer cannula hub is locked therein." (Emphasis added). Indeed, Viola's slide block 74 does not inhibit rotation of the outer cannula. (See FIG. 3). Moreover,

Application No. 10/803,698  
Reply to Office Action of February 28, 2006

Docket No.: 65937-0047

the Examiner has not shown where Viola discloses the inhibition of rotation "when the outer cannula hub is locked therein," as claim 1 recites.

Thus, at least because Viola does not disclose each and every element of claim 1, claim 1 is in condition for allowance.

**C. Dependent Claims 2 – 8 and 17 – 20**

Claims 2 – 8 and 17-20 depend from claim 1. Thus, for at least the same reasons as claim 1, claims 2 – 8 and 17-20 are also in condition for allowance. Moreover, the dependent claims include independently patentable elements.

For example, claim 2 recites in part "wherein the indexing guide includes at least one guide lock that is selectively engagable with the outer cannula hub to inhibit rotation and axial movement thereof." (Emphasis added). Viola does not teach a guide lock and does not teach a guide lock that is "selectively engagable." Thus, claim 2 is independently patentable.

Claim 3 recites "wherein the indexing guide includes two guide locks." The Examiner cites that Viola includes indexing knobs 76. However, the indexing knobs are not guide locks. (See FIG. 3).

Claim 5 recites "wherein the outer cannula hub includes at least one notch and the guide lock is configured to be received in the notch to prevent movement of the outer cannula hub in a first axial direction." The Examiner cited Viola including "between 74 & 76" as allegedly anticipating claim 5. (See the Office Action, Page 3; Viola, FIG. 3). However, Applicants cannot determine from the drawings or the description where "at least one notch" and "configured to be received in the notch to prevent movement of the outer cannula hub in a first axial direction" are shown in Viola. Thus, Applicants request that the Examiner more particularly point to the recited claim elements or withdraw the rejection.

Claim 7 recites "wherein the cradle includes a pivotable clamp that is selectively engagable with the handpiece to inhibit rotation and axial movement thereof." The Examiner cites a passage of Viola that does not disclose a "pivotable clamp," that claim 7 recites. (See the Office Action, Page 4; Viola, Col. 7, Lines 6-22). Thus, because Viola does not disclose a "pivotable clamp," claim 7 is independently patentable.

Claim 8 recites "wherein the adapter includes a deployment mechanism configured to move the cradle relative to the base." The Examiner cites a knife driver subassembly 44 of

Application No. 10/803,698  
Reply to Office Action of February 28, 2006

Docket No.: 65937-0047

Viola. (See the Office Action, Page 4; Viola, Col. 6, Lines 37-45). However, claim 8 recites "a deployment mechanism configured to move the cradle relative to the base." Viola does not show moving the cradle relative to the base. Viola simply discloses a knife driver that moves knife tube 34. (See Col. 6, Lines 37-45). Thus, claim 8 is independently patentable.

Claim 17 recites "wherein said cradle provides for rotational positioning of the tissue receiving opening." Viola does not disclose that "said cradle provides for rotational positioning." Viola discusses a "basket" 32 (not shown in the drawings). (See Col. 6, Lines 21-24). However, the basket is not positioned by "said cradle," as claim 17 recites. Thus, claim 17 is independently patentable.

Claim 18 recites "further including a clamp selectively positionable to stabilize the biopsy device during a medical procedure." The Examiner cited a passage from Viola that does not disclose a clamp. (See the Office Action; Page 4; Viola, Col. 7, Lines 6-22). Further, claim 18 recites "a clamp selectively positionable," (emphasis added) that Viola does not disclose. Thus, claim 18 is independently patentable.

Claim 19 recites "further including a clamp selectively positionable to allow or inhibit movement of the biopsy device." As discussed above, Viola does not disclose a clamp. Thus, claim 19 is independently patentable.

Claim 20 recites "wherein said clamp engages an outer surface of the biopsy device to inhibit rotation." The Examiner stated "a clamp [...] engages an outer surface (22) of the biopsy device to inhibit rotation." (See the Office Action, Page 4). However, as discussed above, Viola does not disclose a clamp. Thus, claim 20 is independently patentable.

#### **D. Independent Claim 9**

Independent claim 9 recites in part:

a base;

a cradle moveably mounted to the base; and

an indexing guide moveable with the cradle and including a receptacle within which a portion of the medical instrument is received, the indexing guide configured to inhibit rotation and axial movement of the portion of the medical instrument received in the receptacle relative to the indexing guide and the cradle when the medical instrument is locked therein.

Application No. 10/803,698  
Reply to Office Action of February 28, 2006

Docket No.: 65937-0047

(Emphasis added). As discussed above with respect to claim 1, Viola does not disclose “an indexing guide moveable with the cradle,” “the indexing guide configured to inhibit rotation and axial movement of the portion of the medical instrument received [...] when the medical instrument is locked therein.” Thus, because Viola does not disclose each and every element of claim 9, claim 9 is in condition for allowance.

**E. Dependent Claims 10 – 15 and 21 – 24**

Dependent claims 10-15 and 21-24 depend from claim 9. Thus, for at least the same reasons as claim 9, claims 10-15 and 21-24 are in condition for allowance. Moreover, dependent claims 10-15 and 21-24 contain independently patentable elements.

Claims 10-15 and 21-24 contain elements similar to those discussed above with respect to claims 2-8 and 17-20. Thus, for at least the same reasons argued above with respect to claims 2-8 and 17-20, claims 10-15 and 21-24 are also patentable.

**F. Independent Claim 25**

Independent claim 25 recites in part:

a base; and

a cradle moveably mounted to the base and configured to rotatably support the biopsy device therein and allowing for rotational positioning of the tissue receiving opening, the cradle configured to inhibit axial movement of the biopsy device relative to the cradle when locked therein.

(Emphasis added). As discussed above with respect to claim 1, Viola does not disclose “a cradle moveably mounted to the base” and “configured to rotatably support the biopsy device therein.” An additional independently patentable element includes “allowing for rotational positioning of the tissue receiving opening.” Viola teaches an outer cannula 34 that is rotated (shown as rotation E). (See FIGS. 10 and 13). However, Viola does not teach a tissue receiving opening. At best, Viola discusses a “basket” 32 that is not shown in the drawings. (See Col. 6,

Application No. 10/803,698  
Reply to Office Action of February 28, 2006

Docket No.: 65937-0047

Lines 21-24). Thus, because Viola does not teach each and every element of claim 25, claim 25 is in condition for allowance.

**G. Dependent Claims 26 – 29**

Dependent claims 26-29 depend from claim 25. Thus, for at least the same reasons as claim 25, claims 26-29 are in condition for allowance. Moreover, dependent claims 26-29 contain independently patentable elements.

Claims 26-29 contain elements similar to those discussed above with respect to claims 17-20. Thus, for at least the same reasons argued above with respect to claims 17-20, claims 26-29 are patentable.

Application No. 10/803,698  
Reply to Office Action of February 28, 2006

Docket No.: 65937-0047

**CONCLUSION**

In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 65937-0047 from which the undersigned is authorized to draw.

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Respectfully submitted,

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